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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,643	09/27/2003	Scott McCleskey	4508 P	8218

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05/16/2007

EXAMINER

BELANI, KISHIN G

ART UNIT	PAPER NUMBER
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2109

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

14

Office Action Summary

Application No.

10/672,643

Applicant(s)

MCCLESKEY ET AL.

Examiner

Kishin G. Belani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/27/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement submitted on 09-27-2003 has been considered by the Examiner and made of record in the application file.

Drawings

The drawings are objected to because of the following informalities:

Fig. 8, block 815, change "Send File Chip" to – Send File Clip –.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

- In paragraph 0051, line 16, change "agent 401" to – agent 202 --
- In paragraph 0053, files 602a,b and 207a,b,c are sometimes referenced in singular and other times in plural. Please provide a consistent (plural) definition for these file references to match the rest of the specification. Also, on line 10, change "filed" to – files –

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities:

In paragraph D, line 3 of claim 1, change "particular files" to – particular file –.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6, 8, 10, 12, 14, 16, and 19 are rejected under 35 U.S.C. 102 (e) as being anticipated by **Aderton et al. (U.S. Patent Application Publication # 2004/0054764 A1)**.

Consider **claim 1**, Aderton et al. clearly show and disclose a system for the management of the distribution of digital data files (abstract; Fig. 1; paragraph 0052; and paragraph 0062, lines 1-10 that show and describe the claimed invention, including NMS (Network Management System) and data packets (computer files in any format), comprising:

a user digital data storage device (Fig. 1, blocks 110a, 110b, 112a, 112b, 114; paragraph 0055, lines 1-7 that describe these blocks as workstation, personal computer, laptop respectively);

a server computer device (Fig. 1, blocks 120, 124; Paragraph 0056, lines 1-4 that describe these blocks as mainframe computer and storage device or file server respectively);

a network providing communication between said user digital data storage device and said server computer device (Fig. 1, WAN block 102 and LAN block 104; paragraphs 0053 and 0054 that describe these networks); and

an agent stored on a device selected from the group consisting of said user digital data storage device, said server computer device and an additional electronic device, said agent being capable of detecting a particular file and swapping particular files out and replacing said particular file with a new file (paragraph 0061, lines 5-18; paragraph 80,

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lines 13-22; paragraph 83, lines 9-12, that disclose agents on one or more computer systems coupled to the network with which NMS interfaces to monitor and control detection and swapping of an old file with a new file).

Consider **claim 2**, and **as applied to claim 1 above**, Aderton et al. clearly show and disclose a system for the management of the distribution of digital data files, wherein said user digital data storage device is selected from the group consisting of a personal computer, an audio player, a video player, a digital data access and display device (Fig. 1, personal computers 112a and 112b; paragraph 0055, lines 1-7 that describe these blocks in more details).

Consider **claim 4**, and **as applied to claim 1 above**, Aderton et al. clearly show and disclose a system for the management of the distribution of digital data files, wherein said network is selected from the group consisting of the Internet, a local area network, a wireless network and a wide area network (Fig. 1, WAN 102 and LAN 104; paragraphs 0053 and 0054, that describe these blocks in more details).

Consider **claim 6**, and **as applied to claim 1 above**, Aderton et al. clearly disclose a system for the management of the distribution of digital data files, wherein said agent further detects an upgradeable data file (paragraphs 0064-0066 that disclose a process of discovering software configurations and comparing them against MCL (a Master Control List) to verify if the software needs upgrading).

Consider **claim 8**, and **as applied to claim 1 above**, Aderton et al. clearly disclose a system for the management of distribution of digital data files, wherein said agent further replaces said particular file with a new file that is an upgraded file (paragraphs 0066 and 0067 that disclose a process of determining whether a software version is the desired version based on the MCL and installing updated software version onto one or more computer systems).

Consider **claim 10**, Aderton et al. clearly show and disclose a method for the management of distribution of digital data files (abstract; Fig. 1; paragraph 0052; and paragraph 0062, lines 1-10 that show and describe the claimed invention, including NMS (Network Management System) and data packets (computer files in any format)), comprising:

detecting a particular file (paragraphs 0065 and 0066 that describe comparing a software file on one or more network coupled computers against a MCL (Master Control List) of software and determining whether the compared software file is the desired version);

determining if a file associated with said particular file is available in a database (Fig. 4, database settings tab 402, text field marked "Database Name" that is used to configure an interface between the update system and one or more databases used to store update system data, thereby disclosing that the updated file exists in a database);

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determining if a user wishes said associated file to replace said particular file (Fig. 9, identification section 802; paragraph 0080, lines 13-22; Fig. 11A, condition section 806; paragraph 0083, lines 9-12 which disclose that a user can set parameter in the condition field 1110 whether or not to allow updating the file);

if the user wishes said particular file be replaced with said associated file, transferring said associated file to a digital data storage device (paragraph 0067 that discloses installing the updated software file onto one or more computer systems); and

removing said particular file from said digital data storage device (paragraph 0068 that discloses verifying that software update was installed correctly, thereby disclosing that the old version of the software file has been deleted from said digital data storage device).

Consider **claim 12**, and as applied to **claim 10 above**, Aderton et al. clearly disclose a method for the management of distribution of digital data files, wherein said particular file is an upgradeable file (paragraphs 0064-0066 that disclose a process of discovering software configurations and comparing them against MCL (a Master Control List) to verify if the software needs upgrading).

Consider **claim 14**, and as applied to **claim 10 above**, Aderton et al. clearly disclose a method for the management of distribution of digital data files, wherein said associated file is an upgraded file associated with said particular file (paragraphs 0066 and 0067 that disclose a process of determining whether a software version is the

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desired version based on the MCL and installing updated software version onto one or more computer systems).

Consider **claim 16**, and as applied to **claim 10 above**, Aderton et al. clearly disclose a method for the management of distribution of digital data files, wherein said determination of the user's wish further comprises receiving permission to transfer said associated file to said digital data storage device (Fig. 9, identification section 802; paragraph 0080, lines 13-22; Fig. 11A, condition section 806; paragraph 0083, lines 9-12 which disclose that a user can set parameter in the condition field 1110 whether or not to allow updating the file, thereby disclosing receiving user's permission to transfer said associated file to said digital data storage device).

Consider **claim 19**, and as applied to **claim 10 above**, Aderton et al. clearly disclose a method for the management of distribution of digital data files, wherein said particular file is selected from the group consisting of audio files, video files, text files, graphics files, multimedia files, program files and combinations of said audio, video text and graphics files (paragraph 0062, lines 5-7 which disclose that data packets may include executable, text, graphics, software, and other data and applications files).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or non-obviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Aderton et al.** (U.S. Patent Application Publication # 2004/0054764 A1), in view of **Yeager et al.** (U.S. Patent Application Publication # 2004/0088348 A1).

Consider **claim 3**, and **as applied to claim 1 above**, Aderton et al. clearly show and disclose a system for the management of the distribution of digital data files, including a database of stored digital content files (Fig. 4, database settings tab 402, text field marked "Database Name" that is used to configure an interface between the update system and one or more databases used to store update system data, thereby disclosing that the updated file exists in a database); a communications application program (paragraph 0061, lines 1-9 that disclose a NMS (network management system) that includes one or more applications installed on one or more servers to provide monitoring and control functions and to interface with one or more agent applications); each of said database of stored digital content files and communications application program being stored on a read/write storage device (the databases and server applications are inherently stored on read/write storage devices).

However, Aderton et al. do not specifically disclose a candidate database and a query database.

In the same field of endeavor, Yeager et al. show and disclose a candidate database and a query database (Fig. 45, blocks 1812, 1814, and 1815; paragraphs 0188, 0189, 0191 that disclose the process used by the mobile agent to collect version and other information from peers concerning one or more documents stored or accessible by the peers. The peer node may search for accessible data (candidate database) and select relevant data files (query database). For example, the mobile agent may include data indicating interest in files with a particular name extension, such

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as “sxi”, “doc”, or “txt”. The peer node may then select the files found that match criteria indicated by the mobile agent. The version information collected may then be stored as part of the mobile agent payload and saved in a database (query database)).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a candidate database and a query database, as taught by Yeager et al., in the system of Aderton et al., so that the searched and extracted records can be preserved for further analysis verifying authorized use of the installed software.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Aderton et al. (U.S. Patent Application Publication # 2004/0054764 A1)**, in view of **Hill (U.S. Patent Publication # 5,761,649)**.

Consider **claim 5**, and **as applied to claim 1 above**, Aderton et al. clearly show and disclose a system for the management of the distribution of digital data files, except disclosing that said agent further detects an unlicensed data file.

In the same field of endeavor, Hill clearly shows and discloses that “Identification and Piracy Detection software” (shown in Fig. 1B) component of said agent further detects an unlicensed data file (Fig. 10A, blocks 315, 316, and 318; column 6, lines 22-26, lines 47-54; column 17, lines 42-49 that disclose the detection means for identifying pirated (unlicensed) copies of the program software that needs updating.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to detect an unlicensed data file, as taught by Hill, in the system of Aderton et al., so as to prevent unauthorized use of pirated software.

Consider **claim 11**, and **as applied to claim 10 above**, Aderton et al. clearly show and disclose a method for the management of distribution of digital data files, except disclosing that said particular file is an unlicensed file.

In the same field of endeavor, Hill clearly shows and discloses that said particular file is an unlicensed file (Fig. 10A, blocks 315, 316, and 318; column 6, lines 22-26, lines 47-54; column 17, lines 42-49 that disclose the detection means for identifying pirated (unlicensed) copies of the program software that needs updating.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to detect an unlicensed data file, as taught by Hill, in the method of Aderton et al., so as to prevent unauthorized use of pirated software.

Claims 7, 13, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Aderton et al. (U.S. Patent Application Publication # 2004/0054764 A1)**, in view of **Dacosta et al. (U.S. Patent Application Publication # 2002/0120725 A1)**.

Consider **claim 7**, and **as applied to claim 1 above**, Aderton et al. clearly show and disclose a system for the management of distribution of digital data files, except

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disclosing that said agent further replaces said particular file with a new file that is a licensed file.

In the same field of endeavor, Dacosta et al. clearly disclose that said agent further replaces said particular file with a new file that is a licensed file (Fig. 2, agent 205; paragraph 0040, lines 1-9 that disclose verification of the license information before downloading an update for use on the client computer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to replaces said particular file with a new file that is a licensed file, as taught by Dacosta et al. in the system of Aderton et al., so as to authenticate that the associated applications are properly authorized for use on the client computer.

Consider **claim 13**, and **as applied to claim 10 above**, Aderton et al. clearly show and disclose a method for the management of distribution of digital data files, except disclosing that said associated file is a licensed file associated with said particular file.

In the same field of endeavor, Dacosta et al. clearly disclose that said associated file is a licensed file associated with said particular file (Fig. 2, agent 205; paragraph 0040, lines 1-9 that disclose verification of the license information before downloading an update for use on the client computer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to verify that said associated file is a licensed file

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associated with said particular file, as taught by Dacosta et al. in the method of Aderton et al., so as to authenticate that the associated applications are properly authorized for use on the client computer.

Consider **claim 17**, and **as applied to claim 10 above**, Aderton et al. clearly show and disclose a method for the management of distribution of digital data files, including searching for a digital data file (as described in claim 10 above), and disclosing that the digital data file is up-to-date (i.e. latest version, as disclosed in claim 8 above).

However, Aderton et al. do not specifically disclose determining if said digital data file is authorized.

In the same field of endeavor, Dacosta et al. clearly disclose that said digital data file is a licensed file (Fig. 2, agent 205; paragraph 0040, lines 1-9 that disclose verification of the license information before downloading an update for use on the client computer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to verify that said digital data file is a licensed file, as taught by Dacosta et al. in the method of Aderton et al., so as to authenticate that the associated applications are properly authorized for use on the client computer.

Consider **claim 18**, and **as applied to claim 17 above**, Aderton et al. clearly show and disclose a method for the management of distribution of digital data files,

including disclosing that the digital data file is up-to-date (i.e. latest version, as disclosed in claim 8 above).

However, Aderton et al. do not specifically disclose that said digital data file is a licensed file.

In the same field of endeavor, Dacosta et al. clearly disclose that said digital data file is a licensed file (Fig. 2, agent 205; paragraph 0040, lines 1-9 that disclose verification of the license information before downloading an update for use on the client computer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to verify that said digital data file is a licensed file, as taught by Dacosta et al. in the method of Aderton et al., so as to authenticate that the associated applications are properly authorized for use on the client computer.

Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aderton et al. (U.S. Patent Application Publication # 2004/0054764 A1), in view of Katz et al. (U.S. Patent Application Publication # 2002/0091799 A1).

Consider **claim 9, and as applied to claim 1 above**, Aderton et al. clearly show and disclose a system for the management of distribution of digital data files, except disclosing that said agent further provides a user with a clip preview of said new file.

In the same field of endeavor, Katz et al. clearly disclose that said agent further provides a user with a clip preview of said new file (Fig. 9, Library Server Process 460

acting as an agent; paragraph 0030, lines 6-9 and lines 28-31 that disclose selected preview clips included in the digital information file).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a user with a clip preview of said new file, as taught by Katz et al. in the system of Aderton et al., so as to give the customer a sense of the content of a particular digital information file.

Consider **claim 15**, and **as applied to claim 10 above**, Aderton et al. clearly show and disclose a method for the management of distribution of digital data files, except said determination of the user's wish further comprises providing a clip of said associated file.

In the same field of endeavor, Katz et al. clearly disclose that said determination of the user's wish further comprises providing a clip of said associated file (Fig. 9, Library Server Process 460 acting as an agent; paragraph 0030, lines 6-9 and lines 28-31 that disclose selected preview clips included in the digital information file).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a user with a clip preview of said associated file, as taught by Katz et al. in the system of Aderton et al., so as to give the customer a sense of the content of a particular digital information file.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Application Publication # 2003/0195974 A1, inventors: Ronning et al.,
filed 3/25/2003

US Patent Application Publication # 2002/0087662 A1, inventor: Bouet,
filed 12/29/2000

US Patent Application Publication # 2004/0215706 A1, inventor: Lavender et al.,
filed 2/23/2004

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kishin G. Belani whose telephone number is (571) 270-1768. The Examiner can normally be reached on Monday-Thursday from 6:30 am to 5:00 pm.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Perez Gutierrez can be reached on (571) 270-1767 or (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Kishin G. Belani
K.G.B./kgb

May 13, 2007


RAFAEL PEREZ-GUTIERREZ
SUPERVISORY PATENT EXAMINER

5/14/07